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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,372	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24738	5133

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EXAMINER	
KANG, PAUL H	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/382,372	PHILYAW ET AL.	
	Examiner	Art Unit	
	Paul H. Kang	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on March 3, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,098,106 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims cited below of copending Application Nos. 09/382,427 (hereafter referred to as '427) and 09/494,956 (hereafter referred to as '956).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,594,705 B1, and claims 1-27 of US Pat. No. 6,636,896 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the two commonly owned patents.

The claimed inventions in said US Patents teach the present invention substantially as claimed. However, The claimed inventions do not specifically teach in direct response to the step of connecting causing user profile information of the user to be sent to the advertiser's location over the network, receiving the user profile information at the advertiser's location, and generating advertising information to forward to the user based upon the user profile information being forwarded to the advertiser's location and forwarding this advertising information to the

connected user, wherein broadcast of the audio signal causes both a connection to the advertiser's location on the network and a push of user profile information thereto.

In the same field of endeavor, Reese teaches a system for data set selection based upon user profile. Reese teaches transmitting a request that contains a user profile to a server, receiving the profile at the server, and generating the requested information based upon the user's profile (Reese, col. 1, lines 55-63 and col. 4, lines 6-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of content customization based on user profiles, as taught by Reese, into the automatic data retrieval system of the prior art of record for the purpose of increasing the quality and relevance of the retrieved data.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolzien, US Pat. No. 5,761,606 in view of Hudetz et al., US Pat. No. 5,978,773 and further in view of Reese, US Pat. No. 6,374,237 B1.

6. As to claim 1, Wolzien teaches the invention substantially as claimed. Wolzien teaches receiving at a user's computer at a location on the network an audio signal from a broadcast generated by an advertiser over a broadcast network, which audio signal has embedded therein unique coded information (Wolzien, col. 3, lines 25-49);

connecting the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information; extracting the unique coded information from the audio signal in response to the step of receiving (In response to the receipt of the audio/video signal, the system extracts the embedded electronic address for use. Wolzien, col. 3, line 25 – col. 4, line 29 and col. 6, lines 1-58).

However, Wolzien does not specifically teach connecting the user's computer to an advertiser's location without user intervention in response to the step of extracting wherein the unique coded information does not comprise routing information. In the same field of endeavor, Hudetz teaches a system for automatically connecting a user to an advertiser's location based on unique coded information retrieved from an input device (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 9, lines 54-64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of automatically connecting the user to an advertiser's location, as taught by Hudetz, into the system of Wolzien for the purpose of increasing efficiency and user friendliness.

Wolzien-Hudetz teach the invention substantially as claimed. However, Wolzien-Hudetz do not specifically teach in conjunction with the step of connecting causing user profile

information of the user to be sent from the user's computer to the advertiser's location over the network, receiving the user profile information at the advertiser's location, and generating advertising information to forward to the user based upon the user profile information being forwarded to the advertiser's location and forwarding this advertising information to the connected user, wherein broadcast of the audio signal causes both a connection to the advertiser's location on the network and a push of user profile information thereto.

In the same field of endeavor, Reese teaches a system for data set selection based upon user profile. Reese teaches transmitting a request that contains a user profile to a server, receiving the profile at the server, and generating the requested information based upon the user's profile (Reese, col. 1, lines 55-63 and col. 4, lines 6-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of content customization based on user profiles, as taught by Reese, into the automatic data retrieval system of Wolzien-Hudetz for the purpose of increasing the quality and relevance of the retrieved data.

7. As to claims 3 and 4, Wolzien-Hudetz-Reese teach storing profile information at a remote location, retrieving the information in response to the step of extracting (Hudetz, col. 9, lines 54-64 and Reese, col. 4, lines 6-21).

Response to Arguments

Applicant's arguments filed March 3, 2005 have been fully considered but they are not persuasive. The applicants argued in substance that:

A) U.S. Patent Nos. 6,829,650, 6,594,705 and 6,636,896 have "no mention of sending profile information to an advertising location. As such, Applicants believe that this...does not obviate Applicants' present inventive concept." Applicants argue further the combination of the three references in combination Reese does not obiate or anticipate Applicants' present inventive concepts. "Applicants believe that there is more required than just the concept of content customization."

The examiner respectfully disagrees with the applicants' arguments. The commonly owned patents deal with system for using audio signals for effecting a connection to a network. All systems prompt the user to access some type of commercial or product oriented data. For instance, claim 6 of the '650 patent recites that a unique code include advertisement messages, product identifications or product descriptions. The teachings of these references are in the same field of endeavor as Reese. Reese, like the references at issue here, aim to transfer data to a user over the network. In the field of client/server network communications, the artisan of ordinary skill in the art at the time of the invention would have found it obvious to customize the client/server session to serve pertinent and customized data to users. It is without question, a system like that of the '650 patent would benefit from using advertisements customized for the user. It would have been obvious to the artisan to have incorporated the data customization, as taught by Reese, into the system for transferring product, television broadcast or advertisement related information.

It is worth noting applicant has not addressed the double-patenting rejection of claims 1 and 2 over co-pending application 09/494,956. This rejection has been maintained above.

B) the combination of Wolzien, Hudetz and Reese is improper as having "no motivation or teaching that would even suggest that one would want to send profile information to any location."

Wolzien teaches enables a remote user to access information including advertisements through video and audio signals (Wolzien, col. 1, lines 33-62). Hudetz teaches a system for providing information related to a product and to direct a consumer to the manufacture's website (See Hudetz, abstract). Both Wolzien and Hudetz attempt to solve the problem of getting product related, commercial, or advertisement related information to the consumer. The nature of the problem tackled by Reese is also getting such information to the consumer. However, Reese proposes customizing the information to the particular user, thereby increasing the effectiveness of the information The artisan or ordinary skill in the art would have found obvious the value of acquiring information about a specific user to customize the information served.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PAUL H. KANG
PRIMARY PATENT EXAMINER